

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

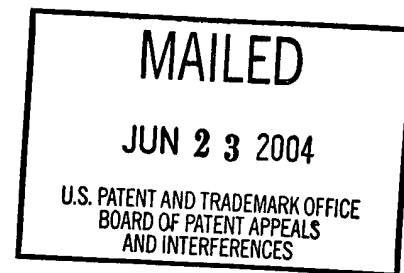
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LORONZO H. THOMSON,
BRIAN THOMSON,
and
MARK P. MCJUNKIN

Appeal No. 2004-1352
Application No. 09/658,509

ON BRIEF



Before GARRIS, WARREN, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2003) from the examiner's final rejection of claims 1 through 4, 6 through 14, and 16 through 27 (final Office action mailed May 1, 2003, paper 18), which are all of the claims pending in the above-identified application.

The subject matter on appeal relates to a bicycle stem for connecting a bicycle handlebar to a bicycle steering tube. According to the present specification (page 4, lines 18-21), "an object of the invention is to provide a bicycle stem and associated methods wherein a secure and rugged connection is made to the handlebars." Further details of this appealed subject matter are recited in representative claims 1 and 20 reproduced below:

1. A bicycle stem for connecting a bicycle handlebar to a bicycle steering tube, the bicycle stem comprising:

a body portion having a tubular shape with a hollow interior and opposing first and second ends;

a handlebar clamping portion having a first arcuate extent and connected to the first end of said body portion;

a handlebar clamping member having a second arcuate extent and cooperating with said handlebar clamping portion to clamp the bicycle handlebar therebetween;

said handlebar clamping member and said handlebar clamping portion each having a recess for the handlebar and a cavity in a respective medial portion of the recess to accommodate an enlarged diameter portion of the handlebar, the cavity in said recess of said handlebar clamping portion extending fully over the first arcuate extent thereof, and the cavity in said recess of said handlebar clamping member extending fully over the second arcuate extent thereof, wherein the cavity of said handlebar clamping portion has an opening therein in communication with the hollow interior of said body portion;

at least one fastener for securing said handlebar clamping member to said handlebar clamping portion;
and

a steering tube clamping portion connected to the second end of said body portion.

20. A bicycle stem for connecting a bicycle handlebar to a bicycle steering tube, the bicycle stem comprising:

a body portion having a tubular shape defining a hollow interior;

a handlebar clamping portion having a first arcuate extent and connected to an end of said body portion and having a recess therein for the handlebar, said handlebar clamping portion further having an opening in a medial portion of the recess in communication with the hollow interior of said body portion;

a handlebar clamping member having a second arcuate extent and cooperating with said handlebar clamping portion to clamp the bicycle handlebar therebetween, said handlebar clamping member having a recess for the handlebar and a cavity in a medial portion of the recess, the cavity in said recess of said handlebar clamping member extending fully over the second arcuate extent thereof; and

at least one fastener for securing said handlebar clamping member to said handlebar clamping portion.

The examiner relies on the following prior art references as evidence of unpatentability:

Jeshurun et al. (Jeshurun)	5,165,301	Nov. 24, 1992
Lai	5,509,328	Apr. 23, 1996
Roddy	5,881,606	Mar. 16, 1999 (filed Feb. 26, 1997)
Giard	6,058,800	May 09, 2000 (filed Jul. 13, 1998)

The claims on appeal stand rejected as follows:

I. claims 1 through 4, 9, 10, 20 through 22, and 24 through 27 under 35 U.S.C. § 103(a) as unpatentable

over Giard in view of Jeshurun and Lai (examiner's answer mailed Jan. 22, 2004, paper 22, page 3; final Office action, pages 4-7);

II. claims 1 through 4, 6 through 8, 11 through 14, and 16 through 19 under 35 U.S.C. § 103(a) as unpatentable over Roddy in view of Jeshurun, Giard, and Lai (answer, page 3; final Office action, pages 7-10);

III. claims 20, 22, and 23 under 35 U.S.C. § 103(a) as unpatentable over Roddy in view of Giard and Jeshurun (answer, page 3; final Office action, pages 10-12);
and

IV. provisionally, claims 1 through 4, 6 through 14, and 16 through 27 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1, 3, 15, 24, 27, 31, 33, 35, 38, 40, 43, and 45 of copending application 09/658,389 in view of Roddy, Giard, and Jeshurun (answer, page 3; final Office action, pages 2-4).

We affirm all four rejections. Because we are in substantial agreement with the examiner's factual findings and

legal conclusions, we adopt them as our own and add the following comments for emphasis.¹

I. 35 U.S.C. § 103(a): Claims 1-4, 9, 10, 20-22, & 24-27 over
Giard, Jeshurun, & Lai

Like the appellants, Giard describes a bicycle handlebar stem for attaching a handlebar to a steering tube of a bicycle. (Column 1, lines 6 and 7; column 1, line 61 to column 2, line 38.) Giard teaches that the stem 27 includes a stem body having a tubular central portion 28, a first end 31 to which is attached a first clamping means for attaching the stem 27 to a steering tube 26, and a second end 31 to which is attached a second clamping means for attaching the tubular portion of a handlebar 23 to the stem 27. (Column 3, lines 9-15; Figure 2.) Regarding the second clamping means, Giard teaches (column 3, line 60 to column 4, line 6; Figures 3-11.):

On the opposite end 32 of the stem 27 is the second clamping means for attaching the handlebar 23 to the stem 27. The second clamping means is essentially comprised of an arcuate-shaped end portion 43 of the stem defining an inwardly recessed first

¹ The appellants submit: "For the purposes of addressing the rejections under 35 U.S.C. §[103 and obviousness-type double patenting, the grouping of the claims is: Claims 1-4, 6-14 and 16-27 stand or fall together." (Appeal brief filed Oct. 9, 2003, paper 21, p. 5.) Accordingly, with respect to rejections I, II, and IV, we select claim 20 and confine our discussion on each of the rejections to this single claim. For rejection III, we select claim 1 and confine our discussion to this single claim. 37 CFR § 1.192(c)(7) (2003) (effective Apr. 21, 1995).

semi-cylindrical surface 45, and a cooperating arcuate-shaped cover member 44 defining a second substantially cylindrical surface 46. The arcuate-shaped end portion 43 of the stem and the arcuate-shaped cover member 44 together define a substantially cylindrical opening 47 having a diameter corresponding generally to the outer circumference of the generally horizontally oriented tubular portion of the handlebar 23. The cover member 44 is attached to the second end 32 of a stem 27 by means of a mechanical hinge 48 and only one fastener 49.

While Giard teaches that the arcuate-shaped end portion 43 and arcuate-shaped cover member 44 both have recesses for accommodating the handlebar as well as cavities (Figure 11), Giard does not teach either of elements 43 or 44 to include a cavity extending fully over the arcuate extent as in the invention recited in appealed claim 20.

To account for the difference between the claimed invention and the closest prior art, the examiner relies on the teaching of Jeshurun. (Final Office action, page 6.) The examiner finds, and the appellants do not dispute, that Jeshurun teaches "a bicycle clamping device compris[ing] a recess for the handlebar 16, 18 and a cavity in a respective medial portion of the recess to accommodate an enlarged diameter portion 14 of the handlebar, the cavity in the recess of the handlebar clamping portion extending fully over a first arcuate extent." (Id.) From this teaching, the examiner concludes: "It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to modify the clamping device of the Giard [stem] with the recess and cavity formed clamping device as taught by Jeshurun et al. in order to provide a safer vehicle wherein the movement of the handlebar in axial direction is prevented." (Id.)

The appellants do not take issue with the examiner's determination that the combination of Giard and Jeshurun would result in the invention recited in appealed claim 20. Rather, the appellants' principal argument on appeal is: "The Examiner's proposed modification of the Giard clamping device to include a centered groove as taught by Jeshurun would render the Giard device unsatisfactory for its intended advantage because the use of a single centered fastener would be prevented." (Appeal brief, page 7.)

We cannot agree with the appellants. As pointed out by the examiner (answer, page 4), one of ordinary skill in the art would have found it prima facie obvious "to utilize the teaching of Jeshurun in the clamping device of Giard so that a centered groove may be formed in the clamp section 44 without over-extending to the fastener 56 of Giard..." In this regard, the examiner correctly points out (answer, pages 3-4) that "[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the

primary reference.[] Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

We do not have to discuss Lai because its teachings are unnecessary to support the rejection of appealed claim 20.

For these reasons, we uphold the examiner's rejection on this ground.

II. 35 U.S.C. § 103(a): Claims 1-4, 6-8, 11-14, & 16-19 over Roddy, Jeshurun, Giard, & Lai

Roddy teaches a clamping device for attaching a handlebar to a steering fork on a bicycle. (Column 1, lines 7-8.) According to Roddy, the clamping device comprises a clamping body 13, a first means 14 for clamping the body to the steering fork, and a second means 15 for clamping the body to the handlebar. (Column 2, lines 62-67; Figures 2-4.) Roddy further discloses that the second means 15 includes a recessed clamping surface 22 in the body 13 of the clamp and cover member 23, which is fastened to the body with fasteners 32 and 33. (Column 3, lines 33-36; column 4, lines 20-32.)

When compared to the invention recited in appealed claim 1, Roddy does not teach the use of a hollow tube as body 13. Nor does it teach the following limitation:

said handlebar clamping member and said handlebar clamping portion each having a recess for the handlebar and a cavity in a respective medial portion of the recess to accommodate an enlarged diameter portion of the handlebar, the cavity in said recess of said handlebar clamping portion extending fully over the first arcuate extent thereof, and the cavity in said recess of said handlebar clamping member extending fully over the second arcuate extent thereof, wherein the cavity of said handlebar clamping portion has an opening therein in communication with the hollow interior of said body portion

Regarding the use of a hollow tubular body, the examiner holds: "It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the solid body portion of Roddy with the hollow body portion of Giard in order to provide a lighter device so that less energy is required to propel the bicycle." (Final Office action, page 9.) As to the recited cavity in the recess of the handlebar clamping member and portion, the examiner reasons: "It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the clamping device of [] Roddy with the recess and cavity formed clamping device as taught by Jeshurun et al. in order to provide a safer vehicle wherein the movement of the handlebar in axial direction is prevented." (Id.)

Again, the appellants do not dispute the examiner's determination that the combination of Roddy, Giard, and Jeshurun

would result in the here claimed bicycle stem. Instead, the appellants' main argument is that "[t]he Examiner's proposed modification of the Roddy clamping device to include a tubular hollow body having an opening in the handlebar clamping portion would render the Roddy device unsatisfactory for its intended advantage because the coverage and engagement of a greater surface area of the circumference of the handlebar would be impeded." (Appeal brief, page 9.)

The appellants' position is without merit for the reasons well stated in the answer (pages 4-5.) Also, our reviewing court in In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) provided guidance as follows:

Gurley's position appears to be that a reference that teaches away "cannot" serve to create a prima facie case of obviousness. We agree that this is a useful general rule. However, such a rule can not be adopted in the abstract, for it may not be applicable in all factual circumstances. Although a reference that teaches away is a significant factor to be considered in determining unobviousness, the nature of the teaching is highly relevant, and must be weighed in substance. A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.

The facts in Gurley's record are that this use of epoxy was known, the structure of these circuit boards was known, and epoxy had been used for Gurley's purpose. We share Gurley's view that a person seeking to improve the art of flexible circuit boards, on learning from Yamaguchi that epoxy was inferior to polyester-imide resins, might well be led to search beyond epoxy for improved products. However,

Yamaguchi also teaches that epoxy is usable and has been used for Gurley's purpose. The Board recognized Yamaguchi's teaching of the deficiencies of epoxy-impregnated material, but observed that Gurley did not distinguish his epoxy product from the product described by Yamaguchi. On the facts of this case, Gurley's teaching away argument was insufficient to establish patentability. Gurley did not offer specific epoxies, or improved properties, and we are not presented with the question of whether any such products might meet the requirements of patent ability. Even reading Yamaguchi's description as discouraging use of epoxy for this purpose, Gurley asserted no discovery beyond what was known to the art. [Underlining added.]

Here, as in Gurley, the appellants have not established any "discovery beyond what was known to the art."

The appellants argue that Giard does not disclose any reason for the openings shown in Figures 9 and 11 therein. (Appeal brief, page 9.) We agree with the examiner's position as stated in the answer (pages 5-6.) Moreover, as admitted by the appellants, Giard teaches cavities or openings in the handlebar clamping portion. Just as the combination of Giard and Jeshurun results in the invention recited in appealed claim 20, the same combination results in the invention recited in appealed claim 1.

Lastly, the appellants urge that Jeshurun does not include any drawings or detailed discussion of a clamping device of the type recited in the appealed claim 1. (Appeal brief, page 10.)

Again, we are in full agreement with the examiner's reasoning as set forth in the answer (pages 6-7).

We see no need to discuss Lai because it is unnecessary to support the rejection of appealed claim 1.

III. 35 U.S.C. § 103(a): Claims 20, 22, & 23 over Roddy, Giard, & Jeshurun

The appellants do not argue this rejection separately. Accordingly, we affirm this rejection for the same reasons discussed in I or II above.

IV. Double Patenting: Claims 1-4, 6-14, & 16-27 over the Claims of Application 09/658,389, Roddy, Giard, & Jeshurun

The appellants argue that, unlike the claims of the copending application, the appealed claims including appealed claim 20 recite "a cavity in the recess of the handlebar clamping portion extending fully over the first arcuate extent thereof, and/or that the cavity in the recess of the handlebar clamping member extends fully over the second arcuate extent thereof." (Appeal brief, page 12.)

We point out, however, that the examiner has acknowledged these differences and accounted for them in the final Office action (pages 2-4.)

Because the appellants present no argument or evidence demonstrating reversible error in the examiner's reasoning, we affirm.


Summary


In summary, we affirm the examiner's rejections under: (i) 35 U.S.C. § 103(a) of appealed claims 1 through 4, 9, 10, 20 through 22, and 24 through 27 as unpatentable over Giard in view of Jeshurun and Lai; (ii) 35 U.S.C. § 103(a) of appealed claims 1 through 4, 6 through 8, 11 through 14, and 16 through 19 as unpatentable over Roddy in view of Jeshurun, Giard, and Lai; (iii) 35 U.S.C. § 103(a) of appealed claims 20, 22, and 23 as unpatentable over Roddy in view of Giard and Jeshurun; and (iv) the judicially created doctrine of obviousness-type double patenting of appealed claims 1 through 4, 6 through 14, and 16 through 27 as unpatentable over claims 1, 3, 15, 24, 27, 31, 33, 35, 38, 40, 43, and 45 of copending application 09/658,389 in view of Roddy, Giard, and Jeshurun.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED


Bradley R. Garris)
Administrative Patent Judge)


Charles F. Warren) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND


Romulo H. Delmendo) INTERFERENCES
Administrative Patent Judge)

RHD/jlb

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